

the magnetic material of the primary frame magnetically engages in a lateral manner with the magnetic material of the auxiliary frame for securing said auxiliary frame to said primary frame;

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[the arm extends over] the second bridge[, which] can support the arm, to prevent the auxiliary frame from moving downward relative to the primary frame; and

[the flange is located behind] the second bridge is located in front of the flange to further secure the auxiliary frame to the primary frame, and to reduce the likelihood of the auxiliary frame from being disengaged from the primary frame if the auxiliary frame is being pulled forward relative to the primary frame.

#### Remarks

The Examiner has rejected all of the pending claims under 35 U.S.C. § 103 as being unpatentable over either U.S. Patent 5,737,054 (the "Chao1 Patent") or the Chao1 Patent in view of U.S. Patent 5,568,207 (the "Chao2 Patent"). In this response, Applicant has amended Claims 14 and 15 for stylistic reasons. No new material has been introduced.

Applicant appreciates the Examiner's comments in his Office Action to the above-identified application. Because of the care that the Examiner has exhibited in his Office Action, Applicant has been able to fully appreciate and understand the Examiner's reasons and grounds for the rejections.

The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made.<sup>1</sup> For

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<sup>1</sup>*In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

the reasons to be stated below, Applicant respectfully traverses the Examiner's rejections of the claims.

#### Functional Differences In Claims 7, 13 and 15

In the last two sentences of the paragraph bridging pages 2 and 3, regarding Claims 7, 13 and 15, the Office Action stated that "the arrangement differences [of, for example, the magnetic material in the auxiliary frame] are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from the changes." The Rejection further argued that, "It appears that these changes produce no functional differences and therefore would have been obvious."

#### Broad Conclusory Statements Are Insufficient

Broad conclusory statements regarding the teaching of a reference is not evidence. There has to be actual evidence that is clear and particular.<sup>2</sup> "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."<sup>3</sup> "The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."<sup>4</sup>

The rejections in the Office Action are broad conclusory statements: The invention is obvious because they are considered "obvious design choices"; "unless unobvious or unexpected

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<sup>2</sup>*Bard v. M3*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

<sup>3</sup>*McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993)

<sup>4</sup>*In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)

results are obtained from the changes", the invention is not patentable. Such broad conclusory statements are not sufficient to support the rejection.

#### Functional Advantages

The Rejection argued that Applicant's invention produced no functional advantages over the Chao1 Patent. Applicant respectfully disagrees.

#### Protecting Lenses From Scratches

One benefit of Applicant's invention comes from protecting lenses in the auxiliary and the primary frame from scratching each other.

One of ordinary skilled in the art would have known that the arm 24 of the auxiliary frame in Applicant's invention has to be made slightly longer than the width of the bridge 11 of the primary frame. Otherwise, the auxiliary frame cannot be secured to the primary frame. This is because the flange 25 has to fit over the bridge 11. With the arm slightly longer than the width of the bridge, the auxiliary frame can be secured to the primary frame.

When the auxiliary frame is secured to the primary frame, the magnetic coupling between the magnetic materials in the primary and the auxiliary frame pushes the auxiliary frame away from the primary frame. The reason of such pushing is due to the fact that the magnetic coupling in Applicant's invention is lateral in direction. When the materials are coupled together, the auxiliary frame is automatically pushed away. This pushing effect is built into Applicant's frames due to the positions of the magnetic materials.

Since the arm 24 is slightly longer than the width of the bridge 11, the magnetic coupling in Applicant's invention ensures a gap between lenses in the auxiliary and the primary frame. This gap protects the two sets of lenses from scratching each other.

### Magnets Have Longer Lifetime

Another benefit of Applicant's invention comes from preserving the lifetime of the magnet, in view of manufacturing defects. The reason is because two coupled magnets will quickly lose their magnetic power if they are forced to be constantly misaligned. This benefit is better illustrated by the embodiment with magnets in both the primary and the auxiliary frame.

Assume that the arm 24 in Applicant's invention is a bit shorter than what it should be. The auxiliary frame probably will not be able to fit over the primary frame, and would be considered defectively manufactured. Such frames would not be distributed in the market place.

Similarly, assume that the projection 22 in the Chao1 Patent is again a bit shorter than what it should be. In this situation, the auxiliary frame may still be able to attach to the primary frame by the coupling effects of the magnets. However, the magnets are mis-aligned, with the magnet in the auxiliary frame offset from the magnet in the primary frame. Such frames might still be distributed in the market place because the auxiliary frame can probably still be attached to the primary frame. Unfortunately, the magnets will quickly lose their magnetic power due to misalignment. Such defective products circulating in the market place would hurt the reputation of the company, and the future sale of the frames.

Thus, Applicant's invention does produce a number of functional advantages, which cannot be considered obvious over the Chao1 Patent.

### Claims 7, 13 and 15: Specific Structures Not Described In the Chao1 Patent

In the second to the last paragraph on page 2 of the Office Action, Claims 7, 13 and 15 were rejected under 103(a) as being unpatentable over the Chao1 Patent. The Office Action described the Chao1 Patent having the structure of "the arm including a rear end having a flange

(24) extended downward for engaging with the first bridge ... the flange (24) including a second magnet for engaging with the first magnet (14)...."

There is no description in the detailed description of the preferred embodiment of the Chao1 Patent of the so-called "downwardly-extended flange (24)" itself not being a magnet, includes a magnetic material for engaging laterally with the magnetic material of the primary frame.

Claims 7, 13 and 15 specifically include the limitation of a downwardly-extended flange, itself not being a magnet, includes a magnetic material. Claims 7, 13 and 15 further include the limitation of the magnetic material for engaging laterally with the magnetic material of the primary frame.

#### Hindsight Reconstruction Is Not Allowed

The Court of Appeal of the Federal Circuit has stated, "[V]irtually all [inventions] are combinations of old elements."<sup>5</sup> Thus, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."<sup>6</sup>

In other words, the Office Action cannot, based on hindsight gained from Applicant's invention, argue that it is obvious to have a downwardly-extended flange, itself not being a magnet, including a magnetic material for engaging laterally with the magnetic materials in the primary frame.

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<sup>5</sup>*Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983).

<sup>6</sup>*In re Fine*, 5 USPQ 2d 1600 (Fed. Cir. 1988)

Suggestions Have To Come From The Chao1 Patent

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness..."<sup>7</sup>

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."<sup>8</sup>

"The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art."<sup>9</sup> While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by Applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein.<sup>10</sup>

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<sup>7</sup>*In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

<sup>8</sup>*W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed.Cir.1983)

<sup>9</sup>*Libbey-Owens-Ford v. BOC Group*, 655 F. Supp. 897, 903; 4 USPQ 2d 1097, 1103 (DCNJ 1987).

<sup>10</sup> *In re Leslie*, 192 USPQ 427 (CCPA 1977).

The Office Action has not provided a reasoned analysis on why one of ordinary skilled in the art would have modified embodiments in the detailed description of the preferred embodiment of the Chao1 Patent to a downwardly-extended flange, itself not being a magnet, including a magnetic material for engaging in a lateral manner with the magnetic material in the primary frame.

Claims 2-6, 9-12 and 14: Not Obvious In View of Chao1 Plus Chao2 Patents

In the first paragraph on page 4, Claims 2-6, 9-12 and 14 were rejected under 103(a) over the Chao1 Patent in view of the Chao2 Patent.

The above arguments are applicable here. For example, again nothing in the detailed description of the preferred embodiment in both the Chao1 and the Chao2 Patents describes (a) the functional advantages of Applicant's invention, and (b) the structures of a downwardly-extended flange, itself not being a magnet, including a magnetic material for engaging in a lateral manner with the magnetic material in the primary frame. Thus, Claims 2-6, 9-12 and 14 could not have been obvious based on the Chao1 and the Chao2 Patent.

In view of the above Remarks, reconsideration of Claims 2-7 and 9-15 is requested.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

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Respectfully submitted,

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